



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,117	04/24/2000	Joseph Stanley Czyszczewski	963.0041USU	8987

25299 7590 11/20/2003

IBM CORPORATION
PO BOX 12195
DEPT 9CCA, BLDG 002
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
----------	--------------

2626

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,117

Applicant(s)

CZYSZCZEWSKI ET AL.

Examiner

Saeid Ebrahimi-dehKordy

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Reifman et al (U.S. patent 5,438,433)

Regarding claim 1 Reifman et al discloses: A multifunction device comprising: a multifunction controller (please note Fig.1 item 12 column 8 lines 31-32) a first interface for receiving input data from at least one document data source (please note Fig.1, column 8 lines 60-63) and a second interface for outputting processed input document data to at least one printer (please note column 8 lines 63-65) and a touch screen implementing a graphical user interface for controlling the operation of said multifunction device (please note Reifman et al, Fig.1 item 18, column 8 lines 35-43) including setting operational parameters for said at least one document data source and said at least one printer (please note column 30 lines 33-59) and for selecting a mode of operation of said multifunction device (please note column 33 lines 28-35).

Regarding claim 2 Reifman et al disclose: A multifunction device as in claim 1, and further comprising another interface for coupling to a facsimile device for outputting processed document data to said facsimile device under control of said graphical user interface (please note column 39 lines 42-49).

Art Unit: 2626

Regarding claim 5 Reifman et al disclose: A multifunction device as in claim 1, wherein said graphical user interface enables a user to access and search databases that are coupled to said multifunction controller through a global data communications network (please note column 62 lines 15-22).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reiman et al (U.S. patent 5,438,433) in view of Kulakowski (WO 97/10668)

Regarding claim 3 Reifman et al disclose: A multifunction device (please note Fig.1 column 8 lines 16-28 and column 9 lines 1-21) under control of said graphical user interface (please note Fig.1 item 18 column 8 lines 60-65) However Reifman et al does not disclose: further comprising another interface for coupling to an e-mail port for outputting processed document data to said e-mail port. On the other hand Kulakowski discloses: further comprising another interface for coupling to an e-mail port for outputting processed document data to said e-mail port under control of said graphical user interface (please note Fig.5 Items 96 and 98 page 15 lines 1-17).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Reifman et al's invention according to the teaching of

Art Unit: 2626

Kulakowski, Kulakowski in the same field of endeavor teach the way email data could be send through the modem or port to other networks and internet.

Regarding claim 4 Kulakowski disclose: A multifunction device as in claim 3, wherein said graphical user interface, when operating in an e-mail mode of operation, provides a single touch screen button for entering an "@" character (please note page 12 lines 33-36).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over parulski et al (Pub No.: US 2001/0013894) in view of Kulakowski (WO 97/10668)

Regarding claims 6,10,14,18,22 and 26 Parulski et al disclose: Apparatus comprising: an image capture device which generates a digital record (please note Fig.4 item 330 page 3 paragraph 0032 lines 1-10) a printer interface which generates printed copy signals corresponding to the digital record (please note Fig.4 item 24, paragraph 0026 lines 1-6) the printed copy signals being effective in printing an image derived from the captured image when coupled to a printer (please note Fig.4 paragraph 0031 lines 1-19 and paragraph 0032 lines 1-10) a controller which couples said image capture device and said printer interface (please note Fig.4 items 18,24 and 330 where coupled together for transmitting digital image, page 3 paragraph 0044 lines 1-13) said controller

Art Unit: 2626

having a touch screen (please note Fig.4 item 303 paragraph 0034 lines 4-8) a first network interface which connects to an area network for bi-directional exchange of digital data (please note Kulakowski Fig.1 items 10, page 8 lines 4-7) and a second network interface which connects to a second network for bi-directional exchange of digital data (please note page 8 lines 16-19) and a control program stored accessibly to and executable on said controller (please note page 16 lines 1-5) said control program when executing implementing a graphical user interface on said touch screen and enabling a user to select delivery of the digital record to a selected one of said printer interface (please note Fig.3 item 56 which is located at each interfaces 14 and 28 of both network 1 and 2, page 11 lines 1-5) said first network interface and said second network interface (please note column 11 lines 1-4 where both interfaces are designated).

Regarding claims 7, 11, 15, 19, 23 and 27 Kulakowski disclose: Apparatus according to Claim 6 wherein said control program when executing on said controller enables a user to access a remotely stored database of address information (please note page 12 lines 7-10)

Regarding claims 8, 12, 16, 20, 24 and 28 Kulakowski disclose: Apparatus according to Claim 6 further comprising: a memory coupled to and housed with said controller (please note Fig.2 page 8 lines 34-36) said control program when executing on said controller further enabling a user to store a database of address information in said memory and enabling access to said database of address information stored in said memory (please note Fig.5 page 12 lines 7-10).

Regarding claims 9, 13, 17, 21, 25 and 29 Kulakowski disclose: Apparatus according to Claim 6 further comprising a memory coupled to and housed with said controller (please note Fig.2 page 8 lines 34-36) said control program when executing on said controller further enabling a user to store a database of address information in said memory and to selectively access one of said database of address information stored in said memory and a second database of address information stored remotely from said controller and accessible through said first network interface (please note Fig.5 page 12 lines 5-10).

Regarding claims 30,32,34 and 35 A method comprising the steps of: capturing a digital record of a document (please note Fig.4 item 330 page 3 paragraph 0032 lines 1-10) executing on a controller having a touch screen a control program which implements a graphical user interface on said touch screen and which enables a user to select delivery of the captured digital record to one of an associated printer (please note Fig.3 item 56 which is located at each interfaces 14 and 28 of both network 1 and 2, page 11 lines 1-5) a first network interface and a second network interface (please note column 11 lines 1-4 where both interfaces are designated) and performing in accordance to such selection one of:

1. delivering the digital record to the printer to generate a copy of the document (please note page 11 lines 3-6)
2. delivering the digital record to the first network interface to generate an electronic mail message (please note Fig.5 pages 12-14).
3. delivering the digital record to the second network interface to generate a

Art Unit: 2626

facsimile transmission to a remote facsimile receiver (please note Fig.5 pages 12-15).

Regarding claims 31 and 33 Kulakowski disclose: The method of claim 30 wherein the format of the electronic mail message is a format selected from the group consisting of PDF and Text (please note Fig.4 page 14 lines 1-5).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Art Unit: 2626

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
November 12, 2003



**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**